

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of May 2, 2008 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 50-0951.

### **Claims Rejections – 35 USC § 103**

Claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application 2002/0019667 to Hicks, III (hereinafter Hicks), in view of U.S. Published Patent Application 2002/0006797 to Virtanen (hereinafter Virtanen).

Applicants respectfully disagree with the rejections and thus have not amended the claims. Applicants, however, have cancelled Claims 8-21. Applicants are not conceding that the cancelled claims fail to present patentable subject matter. The cancellations are solely for the purpose of expediting prosecution. Accordingly, the cancellations should not be interpreted as the surrender of any subject matter, and Applicants expressly reserve the right to present the cancelled claims in any future divisional or continuation applications from the present application.

### **Applicants' Invention Predates Hicks**

As already discussed in the previous response, Applicants believe that any rejections are moot because Applicants' invention predates the earliest effective date, June 6, 2003, of Hicks.

It was asserted on page 3 of the Office Action that the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hicks reference to either a constructive reduction to practice or actual reduction to

practice of the present invention because no supporting document has been produced to show due diligence from the date prior to June 6, 2003 (Hicks reference earliest effective filing date) to the Exhibit A email date of September 25, 2003 related to the instant application.

It is noted that the assignee, IBM, has a strict internal review and evaluation procedure that takes place for each invention disclosure before the invention disclosure is sent to outside counsel for drafting application. During this procedure a comprehensive search is ordered and the in-house patent attorneys/IP professionals assesses the invention in the context of related literature found as a result of the search. The inventors are requested to review and comment on the search results. This procedure can take several months depending on multiple factors, such as the number of invention disclosures received by the in-house patent department, the time required for completing the search, and the time required for the inventors to provide comments on the search results. Due to the large number of invention disclosures received by the IBM in-house patent department, it is believed that the time spent for the review and evaluation procedure for the present invention was reasonable.

Further, Applicants respectfully point to the following paragraphs in MPEP 715.07:

*The purpose of filing a [37 CFR 1.131] affidavit is not to demonstrate prior invention, per se, but merely to antedate the effective date of a reference. See In re Moore, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, "[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity." Id. at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, "the 'conception' and 'reduction to practice' which must be established under the rule need not be the same as what is required*

*in the 'interference' sense of those terms." Id.; accord, In re Borkowski, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974).*

*One difference is that in interference practice a reduction to practice requires a proof that a utility was known, whereas under 37 CFR 1.131 practice, proof of a utility must be shown only if the reference discloses a utility. In re Wilkinson, 304 F.2d 673, 134 USPQ 171 (CCPA 1962); In re Moore, 444 F.2d 572, 170 USPQ 260 (CCPA 1971). Where proof of utility is required, whether or not test results are required to establish the utility of the subject matter in question depends on the facts of each case. The ultimate issue is whether the evidence is such that one of ordinary skill in the art would be satisfied to a reasonable certainty that the subject matter necessary to antedate the reference possessed the alleged utility. In re Blake, 358 F.2d 750, 149 USPQ 217 (CCPA 1966). Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, **whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. Ex parte Hook, 102 USPQ 130 (Bd. App. 1953).***

Accordingly, Applicants respectfully submit that Applicants' Declarations, coupled with the documentary evidence of specific activity on specific dates, clearly evidences Applicants' prior conception and diligence in pursuing a constructive reduction to practice from a time prior to the earliest effective date of Hicks. Applicants therefore respectfully request withdrawal of all rejections in connection with Hicks.

Applicants thus respectfully request that the claim rejections under 35 U.S.C. § 103 be withdrawn.

### **CONCLUSION**

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the

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Reply to Office Action of May 2, 2008  
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Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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